

Application No.: 10/055,968  
Amendment Dated: November 7, 2003  
Supplemental Amendment  
Docket: 103864-129 US1

#### REMARKS

Applicant would like to thank the Examiner for the in-person interview of October 21, 2003. The application has been amended to more clearly define the present invention. New claims 66-69 are added to further capture subject matter the Applicants consider to be their invention. No new matter is added. All arguments submitted in the previous Amendment are incorporated herein. Reconsideration is respectfully requested.

#### Claim Rejections - 35 U.S.C. §103

The Examiner rejects claims 1-53 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,758,095 (Albaum et al.) in view of U.S. Patent No. 5,883,370 (Walker et al.). Applicant respectfully traverses this rejection.

#### A. Claims 1-36

Claim 1 states in combination:

A method of processing prescription requests comprising the steps of:

establishing a connection to a remotely located prescription processing system;

submitting a prescription request to the prescription processing system;

independently assessing by personnel associated with the prescription processing system correctness of the prescription request;

preparing by said personnel a completed prescription form based on the submitted prescription request;

sending the completed prescription form to a filling pharmacy; and

filling the prescription request, at the filling pharmacy, based on the completed prescription form.

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Claim 1 is amended to clarify that a completed prescription form based on the submitted prescription request is prepared by personnel who has independently assessed the correctness of the prescription request. (See Application, page 24, lines 17-18) The personnel, who is associated with the prescription processing system, reviews the prescription request for correctness and transcribes the prescription-related information contained in the prescription request. U.S. Patent No. 5,758,095 (Albaum et al.) does not disclose personnel associated with the system of Albaum that has the skills to independently assess the correctness of a prescription request and to transcribe prescription-related information from a prescription request and complete a prescription form based on the prescription request. Additionally, U.S. Patent No. 5,883,370 (Walker et al.) merely discloses "inputting drug selection into a computer" and "printing out a prescription slip with a prescription bar code which contain pertinent prescription information," not any method of independently checking the correctness of the prescription.

As the combination of elements of claim 1 are not disclosed by Albaum in view of Walker when claim 1 is interpreted as a whole, Applicant respectfully requests that the Examiner withdraw the rejection with respect to claim 1 and its dependent claims 2-36, which incorporate all of the features of claim 1. Moreover, dependent claims 2-36 are independently patentable based on the combination of elements recited therein. An exemplary discussion follows.

Claim 7 recites "transcribing the captured prescription request." As disclosed in the Application, a digitized prescription request is transcribed such that general information is transcribed into a printable or file format or other format (Application, p. 23, lines 9-10) and personnel (see claim 1) transcribes prescription-related information in the digitized

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prescription request to prepare a completed prescription form (Application, p. 24, lines 15-22). A prescription request can be received in a number of ways, including, for example, from a physician's computer, from a telephone, from e-mail, from facsimile, and from wireless/mobile transmission devices. (See Application, p. 20, line 13 to p. 21, line 10). Therefore, methods of transcribing would include transcribing speech (e.g., telephonic prescription request) into text (e.g., printable file format). Albaum et al. does not disclose such a transcription process.

Claim 9 is amended to clarify that the conversion of the capture prescription request to a digitized format takes place at the prescription processing system. As noted in the Application, when the prescription request is submitted by computer (i.e., physician's computer) no conversion is necessary. However, when the prescription request is submitted by some other means, e.g., by telephone, by facsimile, by cellular telephone, etc., the prescription request is converted from an analog to a digital format. (Application, p. 21, lines 10-11).

Albaum et al. does not disclose, for example, "converting the captured prescription request to a digitized format to obtain a digitized prescription request," as recited in claim 9. Albaum merely discloses direct entry of a prescription request into the Albaum system using computer-assisted means. Even when, in the Album system, a prescription request is entered verbally into a computer, requiring the use of speech conversion into digital format, that conversion is done at the user interface rather than at the Album et al. POETRY system. By contrast, in the system of the present invention, prescription requests may arrive at the prescription processing system in a format that requires conversion at the prescription processing system. Album et al does not disclose this conversion at the prescription processing system.

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Claim 18 is amended to clarify that the "existing prescription number" is a unique identification number associated with the completed prescription form for the original prescription request of the prescription to be renewed. The "number" referred to in Albaum et al. with respect to prescription renewals is the number of the medication in the list, as seen in Fig. 9 of Albaum. The medication number recited in claim 18, however, refers to an actual prescription number for the prescription itself, for example, the twelve digit identification number printed on the prescription form. The "prescription number" does not simply refer to the number of the prescription within a list, as in Albaum, but rather a unique identifier that is associated with the prescription from the time the prescription is initially requested. (See Application, p. 32, lines 1-4)

Although not specifically indicated in Albaum et al., it is easy to envision a situation whereby a new prescription request is made using the Albaum system while another existing prescription is cancelled, thus shifting the numbering scheme of the prescriptions listed for a patient in the Albaum system. This supposition is supported by the fact that the prescriptions listed in the Albaum system (e.g., Fig. 9) are in numerical order. If, for example, prescription number four (Gentamicin, in Fig. 9) were cancelled for the patient, then prescription number five (MS, in Fig. 9) would likely be renumbered a number four and the remainder of the prescriptions in the list would be renumbered accordingly. Therefore, the numbers associated with the prescriptions as listed in the Albaum system are not unique identifiers as the prescription numbers of the present invention.

Claim 27 is amended to clarify that the pre-populated form is a tangible form that is printed and, thus, may be sent to the user via facsimile. Albaum et al. does not disclose, for example, "printing" a pre-populated form and "submitting the pre-

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populated form to the user via facsimile," as recited by claim 27. Albaum discloses providing a patient profile screen to physicians, however, Albaum does not disclose, for example, faxing a pre-populated form to a user, for example, a physician.

Claim 28 is amended to clarify the meaning of the "predetermined relationship" that results in the prescription request being filled. Such a predetermined relationship is, for example, a match between the phone number and prescription number submitted by the user and information stored on a database associated with the prescription processing system. (See Application, p. 26, lines 18-20) Furthermore, claim 66 is added to capture the situation where the "predetermined relationship" is not satisfied.

Claim 29 is amended to clarify that a user can communicate with the prescription processing system using telephonic means and can submit a prescription request using, for example, a touch tone telephone keypad. (See Application, p. 20, lines 7-10) Albaum et al. does not disclose that a user may use a telephone to interact with the system of Albaum. There is no telephone interaction between any user and the ordering system of Albaum. The user of a telephone in conjunction with the touch tone telephone keypad to navigate through the prescription processing system of the present invention is not analogous to the computerized voice-entry disclosed in Albaum et al.

As the combination of elements of claims 1-36 are not disclosed in Albaum in view of Walker, Applicant respectfully requests that the Examiner withdraw the rejection with respect to claims 1-36.

**B. Claim 37**

Claim 37 states in combination:

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A method of processing prescription requests comprising the steps of:

establishing a connection to a remotely located prescription processing system;

submitting a prescription request to the prescription processing system;

capturing the prescription request for subsequent manipulation;

processing the captured prescription request;

independently assessing by at least one of a pharmacist and personnel associated with the prescription processing system correctness of the prescription request;

preparing, by said at least one of a pharmacist and personnel a completed prescription form based, at least partially, on the processed prescription request;

sending the completed prescription form to a predetermined pharmacy; and

filling the prescription request, at the predetermined pharmacy, based on the completed prescription form.

As discussed with respect to claim 1, claim 37 is amended to clarify that a completed prescription form based on the submitted prescription request is prepared by personnel who has independently assessed the correctness of the prescription request. As the combination of elements of claim 37 are not disclosed by Albaum in view of Walker when claim 37 is interpreted as a whole, Applicant respectfully requests that the Examiner withdraw the rejection with respect to claim 37.

C. Claim 38

Claim 38 states in combination:

A method of processing prescription requests comprising the steps of:

establishing a connection to a remotely located prescription processing system;

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submitting a prescription request to the  
prescription processing system;

capturing the prescription request;

converting the captured prescription  
request to a digitized format to obtain a  
digitized prescription request;

creating an identification file,  
including identification data, for the  
digitized prescription request;

associating the identification file and  
the digitized prescription request to form a  
prescription file;

storing the prescription file on a  
database maintained by the prescription  
processing system;

transcribing the digitized prescription  
request;

independently assessing by at least one  
of a pharmacist and personnel associated with  
the prescription processing system  
correctness of the prescription request;

preparing, by said at least one of a  
pharmacist and personnel a completed  
prescription form based, at least partially,  
on the processed prescription request;

sending the completed prescription form  
to a filling pharmacy; and

filling the prescription request, at the  
filling pharmacy, based on the completed  
prescription form.

As discussed with respect to claim 1, claim 38 is amended to clarify that a completed prescription form based on the submitted prescription request is prepared by personnel who has independently assessed the correctness of the prescription request. Furthermore, as discussed with respect to claim 7, Albaum does not disclose, for example, "transcribing the digitized prescription request," as recited in claim 38. Moreover, as discussed with respect to claim 9, Albaum does not disclose "converting the captured prescription request to a

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digitized format to obtain a digitized prescription request" or "storing the digitized prescription request on a database maintained by the prescription processing system," as recited in claim 38.

As the combination of elements of claim 38 are not disclosed by Albaum in view of Walker, Applicant respectfully requests that the Examiner withdraw the rejection with respect to claim 38.

D. Claim 39

Claim 39 states in combination:

A method of processing prescription requests comprising the steps of:

- establishing a connection to a remotely located prescription processing system;
- submitting a prescription request to the prescription processing system;
- capturing the prescription request;
- transcribing the digitized prescription request;
- independently assessing by at least one of a pharmacist and personnel associated with the prescription processing system correctness of the prescription request;
- preparing, by said at least one of a pharmacist and personnel a completed prescription form based, at least partially, on the processed prescription request;
- sending the completed prescription form to a predetermined pharmacy; and
- filling the prescription request, at the predetermined pharmacy, based on the completed prescription form;
- determining if the user would like to submit a new prescription request;
- repeating the steps of submitting, capturing, transcribing, preparing, sending, filling, and determining if the user would like to submit a new prescription request;
- and



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terminating the connection if the user would not like to submit a new prescription request.

As discussed with respect to claim 1, claim 39 is amended to clarify that a completed prescription form based on the submitted prescription request is prepared by personnel who has independently assessed the correctness of the prescription request. Furthermore, as discussed with respect to claim 7, Albaum does not disclose, for example, "transcribing the digitized prescription request," as recited in claim 39.

Additionally, Albaum does not disclose, for example, the step of "terminating the connection if the user would not like to submit a new prescription request," as recited in claim 39. The Examiner asserts that Albaum discloses "closing the ordering screen and beginning order processing if the user has completed the orders," citing to Fig. 29 and col. 13, lines 44-54 of Albaum. However, Albaum the cited section of Albaum refers to discontinuing orders and closing an ordering screen. The reference does not disclose that after this ordering screen is closed the user's connection with the Albaum system is terminated altogether. Rather, the reference simply discloses ending a particular mode of operation, namely, ordering new prescriptions. In contrast, the application specifically claims ending the processes of the prescription ordering system, including terminating the connection with the prescription ordering system, if the user decides not to submit a new prescription request. (Application, p. 33, lines 18-20.)

As the combination of elements of claim 39 are not disclosed by Albaum in view of Walker, Applicant respectfully requests that the Examiner withdraw the rejection with respect to claim 39.

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E. Claim 40

Claim 40 states in combination:

A method of processing prescription requests comprising the steps of:

establishing a connection to a remotely located prescription processing system;

submitting a prescription request to the prescription processing system, wherein the prescription request includes user information and a member ID number;

capturing the prescription request;

converting the captured prescription request to a digitized format to obtain a digitized prescription request;

creating an identification file, including identification data, for the digitized prescription request;

associating the identification file and the digitized prescription request to form a prescription file;

storing the prescription file on a database maintained by the prescription processing system;

transcribing the digitized prescription request;

independently assessing by at least one of a pharmacist and personnel associated with the prescription processing system correctness of the prescription request;

preparing, by said at least one of a pharmacist and personnel a completed prescription form based, at least partially, on the processed prescription request;

sending the completed prescription form to a central pharmacy; and

filling the prescription request, at the central pharmacy, based on the completed prescription form.

As discussed with respect to claim 1, claim 40 is amended to clarify that a completed prescription form based on the submitted

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prescription request is prepared by personnel who has independently assessed the correctness of the prescription request. Furthermore, as discussed with respect to claim 7, Albaum does not disclose, for example, "transcribing the digitized prescription request," as recited in claim 40. Moreover, as discussed with respect to claim 9, Albaum does not disclose "converting the captured prescription request to a digitized format to obtain a digitized prescription request" or "storing the digitized prescription request on a database maintained by the prescription processing system," as recited in claim 40.

As the combination of elements of claim 40 are not disclosed by Albaum in view of Walker, Applicant respectfully requests that the Examiner withdraw the rejection with respect to claim 40.

#### F. Claim 46

Claim 46 recites a "header entry agent for retrieving general information from said submitted prescription request and transcribing said predetermined information, wherein said general information comprises non-medication related information comprising at least one of member's name, member's identification number, physician information, and patient information." The header entry agent transcribes general, non-medication related information, into a printable or file format or other format. The header entry agent accesses a digitized prescription request to retrieve the general information. Alternatively, if the prescription request is submitted via facsimile, the header entry agent retrieves the general information from the facsimile printout rather than the digitized prescription request. (See Application, p. 23, lines 7-22) Albaum et al. does not disclose a "header entry agent," which transcribes general information from a prescription request into a printable or file format or other format.

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As the combination of elements of claim 46 are not disclosed by Albaum in view of Walker, Applicant respectfully requests that the Examiner withdraw the rejection with respect to claim 46.

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#### CONCLUSION

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicant reserves the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended

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scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents.

For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

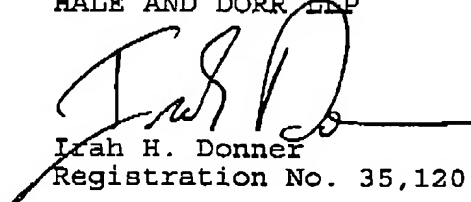
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#### AUTHORIZATION

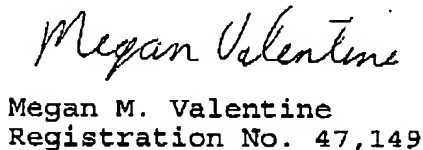
The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to deposit account no. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to deposit account no. 08-0219.

Respectfully Submitted,  
HALE AND DORR LLP



Ira H. Donner  
Registration No. 35,120



Megan M. Valentine  
Registration No. 47,149

1455 Pennsylvania Avenue, NW  
Washington, DC 20004  
Tel: 202-942-8400  
Fax: 202-942-8484  
Date: November 7, 2003